



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,939	04/15/2004	Gerald R. Crabtree	SUPP-P01-007	7564

28120 7590 01/04/2007
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

WOLLENBERGER, LOUIS V

ART UNIT	PAPER NUMBER
----------	--------------

1635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/824,939

Applicant(s)

CRABTREE ET AL.

Examiner

Louis V. Wollenberger

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed 3 November 2006 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 1 May 2006 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

With entry of the amendment filed on 3 November 2006, claims 1, 7, and 20 are pending in the application. Claims 7 and 20 remain withdrawn. Claim 1 is currently under examination.

This application contains claims that are drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

The previous Action noted that Applicants have submitted color drawings and/or photographs as part of the instant application and that color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted.

In reply, Applicants have submitted a set of black and white replacement drawings, and have requested that the drawings be accepted in lieu of the color drawings originally submitted.

Applicants' response is noted; however, in the instant case, black and white drawings submitted by Applicants on 11/3/06 are objected to since, in at least one case (Fig. 6), the

Art Unit: 1635

specification refers to details in the drawing by color. For instance, in the Brief Descriptions of the Drawings at page 8, Fig. 6, Part A, the specification describes the photographs in Fig. 6 according to the color—red or green—of the fluorescence. At least with regard to Fig. 6, a black and white drawing would not be acceptable. Other instances regarding other figures may also exist, but have not been noted here.

Black and white drawings would be acceptable in those instances where color identification is not required or explicitly referred to in the specification and where the quality of the drawings is sufficient for examination of the claims.

Thus, the black and white drawings submitted by Applicants on 11/3/06 are objected to because they do not appear to be of sufficient quality to show the differences in intensity of staining nor the details and localization of the staining, as described in the Brief Description of the Drawings at pages 5-11 of the specification.

It is suggested that Applicants submit a petition for entry of the color drawings along with the fee and additional copies of the drawings.

Claim Rejections - 35 USC § 112, written description—withdrawn

The rejection of Claims 1 and 4 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicants' amendments to the claims.

Claim Rejections - 35 USC § 112, enablement—withdrawn

The rejection of Claim 1 under 35 U.S.C. 112, first paragraph, for lack of enablement is withdrawn.

Claim Rejections - 35 USC § 102—maintained

The rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by Graef et al. (1999) *Nature* 401:703-708 (cited in IDS), as evidenced by Chang et al. (1995) *Nature* 376:686-690 is maintained for the reasons of record as well as for those given below in reply to Applicants' response.

Response to Arguments

Applicants argue that Claim 1, as now amended, is not anticipated by Graef et al., which teaches activation of calcineurin in hippocampal neurons to induce synaptic plasticity and memory formation, rather than promoting axonal growth, as is recited in the claimed invention.

Applicant's arguments filed 11/3/06 have been fully considered but they are not persuasive.

MPEP §2112, states, in part, that

The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure *at the time of invention*, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)

In the instant case, while it may be true that Graef et al. do not teach that introducing calcineurin into hippocampal neurons “promotes axonal growth,” as recited in the preamble of the instant claim, the method shown by Graef et al., comprising the transfection of constitutively calcineurin into rat hippocampal neurons, meets the limitations recited in the body of the claim and would, therefore, inherently perform the intended result—promotion of axonal growth—according to the claimed method (MPEP 2112), and as evidenced by Chang et al.

In the instant case, the body of the claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations (MPEP 2111.02).

Accordingly, the preamble in claim 1 is not considered a limitation and is of no significance to claim construction; therefore, Applicants’ reliance on the preamble is ineffective, since the intended use recited in the preamble does not distinguish the method claimed from that shown in Graef et al.

Claim Rejections - 35 USC § 102—withdrawn

The rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by Serafini et al. (1994) *Cell* 78:409-424 is withdrawn in view of Applicants’ amendments to the claims.

The rejection of Claim 1 under 35 U.S.C. 102(e) as being anticipated by Butler et al. (US 2003/0211608) is withdrawn in view of Applicants’ amendments to the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

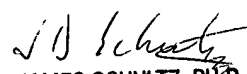
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis V. Wollenberger whose telephone number is 571-272-8144. The examiner can normally be reached on M-F, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached on (571)272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Louis V. Wollenberger, Ph.D.
Examiner
Art Unit 1635
November 29, 2006


JAMES SCHULTZ, Ph.D.
PRIMARY EXAMINER